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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,829	09/29/2000	Cathal McGloin	P-9683-US1	2975
49443 7590 03/18/2009 Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036				
EXAMINER				
LE, LINH GIANG				
ART UNIT		PAPER NUMBER		
3686				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/672,829

**Applicant(s)**

MCGLOIN ET AL.

**Examiner**

MICHELLE LE

**Art Unit**

3686

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Notice to Applicant***

1. This communication is in response to Amendment and Response filed 31 December 2008. Claims 17-41 have been cancelled and claims 42-61 remain pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The claimed invention is directed to non-statutory subject matter. Claims 42-55 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent- eligible. This means the machine or transformation must impose

meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Independent claim 42 is directed towards a performance management method. No particular machine or transformation is recited in the claim. The user interface is only used in the data-gathering step and thus Examiner interprets this as being insignificant extra-solution activity. Thus, the claim 42 and the corresponding dependent claims are non-statutory.

Independent claim 56 is directed towards a performance management system but is not defined by components of a system recognized under 35 USC 101. Under the Nuijten construction of machine is defined as a "concrete thing, consisting of parts, or of certain devices and combination of devices [including] every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." (Quoting *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863)). "An information management function" is not a concrete thing and a software term thus is not recognized as a system component.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 42-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Powers (6,615,182)

6. As per claim 42, Powers teaches a computer-implemented performance management method operable in an enterprise comprising individuals organized according to a hierarchy, the method comprising:  
providing a user interface by which a user defines a data dictionary, the data dictionary defining processing of performance management data, wherein the data dictionary comprises one or more data fields, an operator for defining an operation to be applied to performance management data in at least one of the data fields, and wherein each data dictionary field comprises a user-selectable level of the hierarchy to which the data dictionary field is to be applied (Powers; Col. 1, line 60 to Col. 2, line 12; Col. 11, line 64

to Col. 13, line 42) ;

receiving performance management data (Powers; Col. 4, line 54 to Col. 5, line 2);

applying the received performance management data against the data dictionary

(Powers; Col. 11, line 64 to Col. 13, line 42); and

creating for an employee an individual performance measurement according to the operation at the user-selectable level of the hierarchy (Powers; Col. 4, line 21-41) .

7. As per claim 43, Powers teaches wherein the performance management data includes data aggregated from a first level of the hierarchy to a second level of the hierarchy to generate an aggregate value (Powers; Col. 4, line 21-41; Col. 11, line 64 to Col. 13, line 4).

8. As per claim 44, Powers teaches wherein the first level of the hierarchy is associated with a set of agents and the second level of the hierarchy is associated with a manager of the set of employees (Powers; Col. 3, line 58 to Col. 4, line 20).

9. As per claim 45, Powers teaches wherein each of the set of employees has an associated objective having a value, wherein values of the associated objective for each of the set of employees are aggregated and associated with the manager (Powers; Col. 3, line 58 to Col. 4, line 20).

10. As per claim 46, Powers teaches wherein each of the set of employees is rated on a team objective (Powers; Col. 3, line 58 to Col. 4, line 20).

11. As per claim 47, Powers teaches wherein the performance management data is received from one or more systems (Powers; Col. 4, line 54 to Col. 5, line 2).

12. As per claim 48, Powers teaches generating a report based on a result of applying the received performance data against the data dictionary (Powers; Col. 4, line 21-41).

13. As per claim 49, Powers teaches wherein the operation associates data from a first data field with data from a second data field (Col. 11, line 64 to Col. 13, line 42).

14. As per claim 50, Powers teaches wherein the dictionary entry comprises a rule that defines a value associated with performance management data in at least one of the data fields (Col. 11, line 64 to Col. 13, line 42).

15. As per claim 51, Powers teaches wherein the rule enables a first user in the hierarchy to override a configuration setting of a second user in the hierarchy (Col. 5, lines 32-35).

16. As per claim 52, Powers teaches wherein the configuration setting is overridden by a manager (Col. 5, lines 32-35).

17. As per claim 53, Powers teaches wherein the data dictionary further includes a user-selectable measurement period against which the operation is to be applied (Col. 6, lines 14-20).

18. As per claim 54, Powers teaches wherein the user interface is provided by a web page (Col. 2, lines 15-16).

19. As per claim 55, Powers teaches wherein the hierarchy comprises a first level, and a second level (Powers; Col. 3, line 58 to Col. 4, line 20).

20. Claims 56-61 repeat substantially the same limitations of claims 42-55 and the reasons for rejection are incorporated herein.

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571) 272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/M. L./  
Examiner, Art Unit 3686  
3/15/09

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
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